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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/292,096    04/14/99    GARIBALDI

J    3176-4866

EXAMINER
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QM32/0308

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LEUBECKER, J	
ART UNIT	PAPER NUMBER

3739

DATE MAILED:

03/08/01

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/292,096

Applicant(s)

GARIBALDI ET AL

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 18-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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***Election/Restrictions***

1. Applicant's election of Group I in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It has come to the Examiner's attention that the previous restriction requirement contains an error. Claim 18 was erroneously grouped with Group I instead of Group II. Claim 18 recites "identifying a volume" which requires use of pre-operative image sets, such a MR or CT. Group II relates to this subject matter. In a call to Bryan Wheelock on February 23, 2001, the error was explained. Mr. Wheelock confirmed the election of Group I, claims 1-17.

***Claim Objections***

2. Claims 7 and 15 are objected to because of the following informalities: claim 7, line 8, "place" should be -plane--; claim 15, line 10, "apply to apply" is improper. Appropriate correction is required.

***Claim Objections***

3. Applicant is advised that should claim 9 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

*Claim Rejections - 35 USC § 112*

4. Claims 1 and 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 7, 9 and 10, term “display” (line 8 in claim 1) lacks antecedence. Note that a “display component” is recited in line 5 of claim 1.

As to claim 7, movement of the distal end “in a first plane relative to the indicia” is vague and indefinite. It is not clear how this limits movement to any particular plane.

Claim 8 is ambiguous and indefinite with respect to the properness of physically relating the first plane with the indicia. The first plane is defined at the distal end of the system with by movement of the distal end of the endoscope and a plane including the indicia (it is assumed that Applicant intended to refer to a *plane* that included the indicia since positionally relating a plane to indicia *per se* that is displayed on a screen doesn’t seem to make any sense) is defined as the display surface at the proximal end of the system. Alignment of these two planes appears to be a limited coincidental correspondence which might occur with use of the system.

As to claims 11 and 12, recitation of “at least one magnet body” and “a plurality of magnet bodies” in these claims are ambiguous since claim 1, from which claims 11 and 12 depend, previously recites a “magnetic body”. Are the magnet bodies different or the same as the magnetic body previously claimed?

As to claims 13 and 14, term “magnet body” lacks antecedence. “Magnetic body” was previously claimed.

As to claim 16, note similar defect as described with respect to claim 7.

Dependent claims where present inherit those defects.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-9 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda et al. (U.S. Pat. 5,681,260).

Ueda et al. disclose an endoscope (2) having a magnetic body (20), an imaging device (24, 25 or 5), a display component (7), a magnetic field generating apparatus (11), and a controller (45, 50, Fig.6). The controller (50) can be moved in two mutually perpendicular directions. As to claims 7 and 8, note Figure 46 and col.26, lines 47-51. Although the indicia ("UP") directly indicates the direction of the magnetic force, and thus the direction of movement of the distal end, it will also indicate the relative difference between the vertical direction of the image itself and the vertical movement direction of the distal end. Thus, the orientation of the displayed image is indicated. The indicia will also exactly correspond to the direction indicated by the indicia in the case that the vertical direction of the obtained image corresponds to the vertical with respect to gravitation. As to claim 9, the display component (7) inherently has vertical and horizontal directions (the vertical direction is clearly up and down along the page showing Figure 1(a) and the horizontal direction is left and right). The "UP" direction of movement of the distal end, as mentioned above, corresponds to the vertical direction of the

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display component. As to claim 11, note Figures 25 and 26. As to claim 12, note Figure 14-16, 59 and 60. As to claims 13 and 14, the magnetic body can be a permanent magnetic material or a ferromagnetic material (col.10, line 7).

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. in view of Hibino et al. (U.S. Pat. 5,060,632).

Ueda et al. discloses a controller that is remote from the endoscope. Hibino et al. teaches that it is known to provide a controller that is remote from the endoscope (note Figures 31, 33 and 34, for example) and, alternatively, to provide a controller that is *on* the endoscope, adjacent the proximal end (Fig. 10 or 76, for example). Additionally, the Examiner wishes to point out that, typically, most controllers are disposed on the proximal end of the endoscope, rather than remotely located. The controller can be placed in either location, depending on the desires of the user, comfort level, whether or not the user is present at the procedure or performing the procedure remotely, etc. Since it is known to dispose the controller on the endoscope, at the proximal end, it would have been obvious to the skilled artisan at the time the invention was made to have done so.

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9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. in view of Koninckx (U.S. Pat. 5,899,851).

Ueda et al. discloses a signal processor but fails to disclose the function of orienting the image on the display so that the vertically “up” direction of the image is oriented at the top of the display regardless of the actual orientation of the endoscope. Koninckx teaches to electronically indicate the vertical direction of the image and, more importantly, to electronically orient the image so that the vertically “up” direction of the image is oriented at the top of the display regardless of the actual orientation of the endoscope (col.3, lines 53-55). It would have been obvious to the skilled artisan to have provided the signal processor function taught by Koninckx in the Ueda et al. device for eliminate disorientation or error caused by looking at a non-vertical image.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mizuno et al. (U.S. Pat. 5,876,325)—note col.16, lines 32+ regarding equating the movement direction of the joystick to the movement direction on the display.

Manwaring et al. (U.S. Pat. 5,638,819)—note col.7, lines 4-8 and the vertical indicating indicia in Figures 8 and 9.

Frei et al. (U.S. Pat. 3,358,676)—note magnetic guidance system.

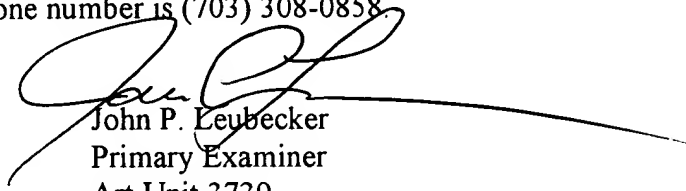
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl  
February 27, 2001